



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,559	04/25/2001	Mark Rumer	05166P008	7598
8791	7590	04/22/2004	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD, SEVENTH FLOOR LOS ANGELES, CA 90025			JUNG, MIN	
			ART UNIT	PAPER NUMBER
			2663	
			DATE MAILED: 04/22/2004	

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,559

Applicant(s)

RUMER, MARK

Examiner

Min Jung

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7,9-11 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,9-11 and 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3 and 16-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains 'subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 now recites "TDM data frame comprises a payload data and a destination field", "writing contents included within the payload field of the TDM data frame to a first field in an Ethernet frame", and "writing contents included within the destination field of the TDM data frame to a second field in the Ethernet frame". These recitations are not supported by the original specification

The limitation of claim 18 is also not supported in the original specification.

3. Claims 1-4, 6-7, 9-11, and 13-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable

one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims are directed to putting TDM stream in an Ethernet packet along with some kind of identification information, and regenerating TDM stream from the Ethernet packet. Specification fails to provide meaningful teachings to make and/or use the invention. It is not clear what TDM data frame is; generally TDM data frame can be understood as T1/E1 type of synchronous transmissions. In synchronous transmission frame format, destination field or other types of source/destination identification is not included because channels are set up in a preset manner. Therefore, TDM data frame comprising payload field and a destination field is contradictory to a conventional knowledge. If TDM data frame in the specification is implemented using something other than synchronous type of communication scheme, it should have been described. It is not understood what applicant is intending to mean by "TDM stream" or "TDM data frame". If each time slot in the TDM frame contains a packet, and the payload and destination information recited are referring to the same included in each packet, a clear teaching regarding such aspect should have been provided. Moreover, TDM block identification is not properly taught. It is not clear if TDM block identification information is extracted from the stream, or derived using other necessary information such as port number, etc, and it is also not clear what is the identity of block identification; is it a sequence number, time slot number, destination ID, port number, type of data, or something else?

Further, specification fails to teach how the TDM stream is written into the first buffer and the second buffer. For example, does each buffer handle one time slot at a time, one frame at a time, a partial frame at a time, or something else? Similar question is raised for generating each Ethernet packet; is a whole frame put into the packet, or some kind of destination specific processing is performed to accumulate information for specific destination to put the accumulated data in the Ethernet packet?

Further, specification fails to provide teachings regarding the appropriate time to insert the data into an outbound TDM data stream (claim 16). It is not taught how the information in destination field is related to the time to insert the data. Is the time indicated in the form of timestamp, sequence number, delay parameter, or something else? If none of these, then how is destination related to the time to insert?

Teaching is simply lacking to make and/or use the invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4, 6-7, 9-11, and 13-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 6, it is not clear what is meant by "payload field" and "destination field" in a TDM data frame; newly provided Fig. 6 representing TDM stream do not show such fields.

In claim 2, line 1, "packetizing includes" is not properly supported by the base claim because packetizing step is nonexistent in the base claim. At line 3, "the TDM block identification information" lacks antecedent basis.

In claim 3, line 1, "packetizing includes" is not properly supported by the base claim because packetizing step is nonexistent in the base claim. At line 4, the word "first" has a typo.

In claims 4 and 10, the identity of "TDM block identification" is unclear.

In claim 6, and some other claims, the word "first" has a typo.

In claims 21-23, it is not clear if the destination of the TDM data frame is indeed a line card in the Ethernet switch. Examiner's understanding is that a line card may be a destination for an Ethernet frame carrying the TDM, but not a true destination of the TDM data.

Response to Arguments

6. Applicant's arguments with respect to claims 1-4, 6-7, 9-11, 13-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Rowett et al. patent, 6,366,583, the Kakuma et al. patent, the Aranguren et al. patent, and the Keenan et al. patents are cited for further references.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 703-305-4363.

The examiner can normally be reached on Monday-Friday, 7AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 703-308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ
April 16, 2004


Min Jung
Primary Examiner